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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 1161

THE GOODYEAR TIRE & RUBBER COMPANY, *Petitioner*

v.

THE COMMISSIONER OF PATENTS, *Respondent*

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI

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Petitioner respectfully prays that this Court grant rehearing of its order of May 16, 1966 denying its petition for writ of certiorari and that a writ of certiorari issue to review the judgment of the Court of Appeals for the District of Columbia Circuit in the present case as prayed for in the petition filed herein March 28, 1966.

It is realized that, based on published statistics, the "odds" in favor of the Court granting the present petition are less than one out of a hundred. However, since we are dealing here with a serious, important matter of law, not a game of chance, petitioner wishes to impress upon the Court, by the present petition, the dire necessity for granting a review of this case on its merits; otherwise justice will be irrevocably denied.

I. REASONS FOR GRANTING REHEARING AND ISSUING WRIT OF CERTIORARI

A. Litigation Against Commissioner of Patents Under Administrative Procedure Act, Being Concentrated in District of Columbia Circuit, Renders Conflict as Basis for Granting Writ of Certiorari Improbable, Except for Conflict Within Circuit

The Supreme Court in *Schriber-Schroth Co.* v. *Cleveland Trust Co. et al.*, 305 U.S. 47; 59 S. Ct. 8 (1938), (a 100-to-one "long shot" which paid off), granted a petition for rehearing of an order denying a petition for writ of certiorari on the ground that the concentration of litigation in a single circuit (the Sixth) on the subject of the petition made it "improbable" that an opportunity for conflict with another circuit would ever arise.

In the present case, it is improbable that a conflict will ever arise in another circuit with respect to an action against the Commissioner of Patents under the Administrative Procedure Act. The Court of Customs and Patent Appeals has no authority to judicially review such actions, and so far the only circuit court in which such actions have arisen, due to the fact that the Commissioner is a resident of the District of Columbia, is the Court of Appeals for the District of Columbia Circuit.

There is, in fact, a conflict *within* the District of Columbia Circuit with respect to the specific question presented here.[1] The conflict lies in the fact that more than 50 years ago the Court of Appeals for this circuit

[1] The Solicitor General's Memorandum in Opposition, footnote 5, page 4, agrees that the ultimate question here is whether or not publication of a mark must take place a second time under Rule 2.81 in the light of the circumstances of the given case.

in *Carter Medicine Co.* v. *Barclay,* 36 App. D.C. 123 (1910) ruled that the Commissioner acted properly in publishing a mark a second time, holding that an applicant *should* be subjected to the hazards of publication of a mark a second time if it is "possible for an opposition to lie against the amended application, and not against the original". In the present case the Commissioner refuses to publish the mark a second time, the Court holding now that a second publication should *not* take place even though it is "possible for an opposition to lie against the amended application and not against the original". To paraphrase the statement of Mr. Justice Stewart in his dissenting opinion in the recent case of *United States* v. *Von's Grocery Company, et al.,* 34 Law Week 4425 (U.S. May 31, 1966), and to apply it to the situation presented here, "The sole consistency that I can find is that in litigation [against the Commissioner of Patents] the government always wins."

B. Other Grounds for Opposition Which Now Exist But Which Did Not Exist When Mark Was First Published

1. New Specimens Filed After First Publication

Since new specimens were filed *after* the first publication, it is abundantly clear that "a ground for opposition to the mark" was raised by this change in the application which was not present in the original application. The matter is prejudged if petitioner is not afforded an opportunity at least to show that it is "possible for an opposition to lie against the amended application", which possibility did not exist when the mark was first published. There were *no* specimens in the record at the time of first publication from which it could be determined whether or not the mark was

ever used on the goods named in the application, or if ever used, whether such use was in "foreign" rather than "interstate" commerce and whether or not the specimens showed use of the mark on goods of which the mark was merely descriptive, deceptive, deceptively misdescriptive, or generic.[2]

In other words, the Court of Appeals for the District of Columbia Circuit held, on the one hand, in *Carter Medicine Co.* v. *Barclay, supra,* that there *should* be a second publication if a *possibility* of opposition exists after amendment which did not exist before amendment; but in the present case, even though a *possibility* of opposition arose after amendment (by addition of specimens) which did not exist before amendment (because there were *no* specimens showing use of the mark on the goods named in the application), the Court *refuses* to order a second publication. It is impossible for the Patent Office or the Court to be sufficiently omniscient to foresee and prejudge all of the *possibilities* of opposition which might arise from the inclusion of new specimens in an application after the mark was first published, particularly where the application was formerly rejected by the Examiner for lack of specimens. Petitioner is entitled to his "day in Court" to be heard on the sufficiency of such

---

[2] The Solicitor General (Memorandum in Opposition, footnote 4, page 3) takes the position that "Lack of proper specimens is not a proper ground for opposition. It is a matter easily correctable and, in any event, one as to which an opponent would have no ground for complaint. That is why such lack is regarded by the Patent Office as a matter that can properly be considered on an *ex parte* basis."

The Court of Customs and Patent Appeals, however, in *Cardinal Engineering Co.* v. *Champion Mfg. Co.,* 300 F. 2d 957; 133 USPQ 197 (1962) takes a contrary position as to the right of a party to be heard on a so-called *ex parte* issue.

specimens to show lawful use in commerce which may lawfully be regulated by Congress.

2. Court Adjudication Since First Publication

The United States District Court for the District of Minnesota (Third Division) in an opinion dated May 12, 1965 in No. 3-64-Civ. 357 enjoined H. Rosenthal Co. from selling or importing goods bearing the mark in question. *The Goodyear Tire & Rubber Company* v. *H. Rosenthal Co.,* 246 F. Supp. 724, 729; 147 USPQ 92, 95 (D. Minn. 1966). This adjudication took cognizance of, but distinguished the case from, the 78 year old decision of the Supreme Court in *Goodyear's India Rubber Glove Mfg. Co.* v. *Goodyear Rubber Co.,* 128 U.S. 598; 9 S. Ct. 166 (1888).

In view of the existence of a judicial determination that use of "GOODYEAR DELUXE BY WEATHERITE" is unlawful, petitioner now has a ground of opposition which did not exist when that mark was first published.

3. Facts Made of Record After First Publication Show Use on Imported Goods and Investigation by Other Government Agencies as to Lawfulness of Use of Mark in Foreign Commerce

The goods involved in the application are imported from Japan, a fact to which the applicant scrupulously avoided making reference in its representations to the Patent Office. In fact, the application (R. 88) designates only use in "interstate" commerce as the basis for the registration sought. Since the goods are imported from Japan, the first use must have been in "foreign" commerce. Even after it was brought to the

attention of the Commissioner of Patents that applicant was falsely representing that the mark was already registered (R. 17-19) and that the Bureau of Customs, the Federal Trade Commission and even the Department of Commerce itself were investigating the lawfulness of the use of the mark by the applicant (R. 13, 20, 77, 143), the Patent Office accepted the new specimens and ignored the question of lawfulness of use of the mark in foreign commerce between Japan and the United States. In view of the fact that such use has since been judicially determined to be unlawful, the new specimens afford a possible ground for opposition which did not exist at the time of first publication.

4. Possibility That Mark Has Been Abandoned Since First Publication

The record also contains evidence which raises a question as to whether or not the use of GOODYEAR was *abandoned* by applicant *after* the first publication, thereby giving petitioner a ground for opposition which did not exist at the time of first publication. A letter dated October 7, 1964 on the applicant's letterhead, signed by the same officer of the company who signed the affidavit which accompanied the new specimens (R. 69) clearly states that "GOODYEAR markings" would be removed from all shipments to the addressee.

This, coupled with the fact that 14 days later the affiant swore only that the newly submitted specimen *was* in use when the application was originally filed, but does not assert that the mark was *still* in use when he signed the affidavit, leaves open the question as to whether use of GOODYEAR was abandoned by the applicant shortly *before* the time the new specimen was submitted.

5. New "Possible" Grounds of Opposition Meet Criteria for Second Publication of Mark

Each of the *four* points mentioned above constitutes a "possible" ground for opposition which did not lie against the application at the time of first publication but which did lie against the application *after* amendment. Thus the decision of the Court of Appeals for the District of Columbia Circuit in the present case is in *direct conflict* with its own precedent in *Carter Medicine Co.* v. *Barclay, supra.* Unless this is another situation in which "the government always wins", certiorari should be granted and petitioner should at least be given an *opportunity* to win. The government should not be permitted to "eat its cake and have it too" in the District of Columbia Circuit merely by twisting the controlling precedent in this circuit as if it were a "nose of wax" to accommodate the whims of the Commissioner of Patents from one situation to another.

C. Review of Grounds of 1888 Decision of Supreme Court Long Overdue

1. 1888 Decision Being Misused, Misinterpreted and Misrepresented by Applicant

At every turn Weather-Rite has urged, albeit erroneously, that the Supreme Court held in 1888 that "GOODYEAR" is free for everyone to use *today* (R. 99, 119). Even the Solicitor General succumbed to the temptation to try to ride the dead horse (Memorandum in Opposition, footnote 1, page 1). The fact of the matter is that use of "GOODYEAR" as a *trademark* was not involved in the 1888 decision except as *obiter dictum.* The Court actually said:

> "The designation Goodyear Rubber Company not being subject to exclusive appropriation, any

> use of terms of similar import, or any abbreviation of them, must be alike free to all persons." 128 U.S. at 604; 9 S. Ct. at 168.

The District Court in Minnesota (supra, 246 F. Supp. 724, 728; 147 USPQ 92, 94), at least, showed that it was not going to fall for an infringer's interpretation by pointing out that the Supreme Court decision in 1888, while involving company names, did not involve either "secondary meaning" or "passing off"[3] the goods of one party for those of another. Indeed the doctrine of "secondary meaning" did not really evolve until the turn of the century. The trend toward recognition of the right of one party to exclusive use of a trademark which was once a geographical term, a descriptive term, or even a surname, is illustrated by the opinion of Chief Justice Fuller rendered more than a decade after 1888 in *Elgin National Watch Company* v. *Illinois Watch Case Company,* 179 U.S. 665; 21 S. Ct. 270 (1901). In that case Chief Justice Fuller said:

> "It is undoubtedly true that where such a secondary signification has been acquired, its use in that sense will be protected by restraining the use of the word by others in such a way as to amount to a fraud on the public, and on those to whose employment of it the special meaning has become attached.
>
> In other words, the manufacturer of particular goods is entitled to the reputation they have acquired, and the public is entitled to the means of distinguishing between those and other goods; and

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[3] Mr. Justice Field, in the 1888 opinion, said:

"There is no proof of any attempt of the defendant to represent the goods manufactured and sold by him as those manufactured and sold by the plaintiff;" 128 U.S. at 604; 9 S. Ct. at 168.

protection is accorded against unfair dealing, whether there be a technical trademark or not. The essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another." 179 U.S. at 674; 21 S. Ct. at 274.

The doctrine of "secondary meaning" was first accorded statutory recognition in the Trademark Act of 1905. The "ten year proviso" of that Act permitted registration of "any mark used by the applicant or his predecessor * * * which was in actual and exclusive use as a trademark of the applicant, or his predecessors from whom he derived title, for ten years next preceding February twentieth, nineteen hundred and five". The doctrine is carried forward and further liberalized in the Trademark Act of 1946, Section 2(f), wherein the Commissioner is permitted to register any mark "which has become distinctive of applicant's goods in commerce". He is permitted to accept proof of *substantially*[4] exclusive and continuous use as a mark by the applicant in commerce for the five years next preceding the date of filing the application for registration as prima facie evidence that the mark has become distinctive of the applicant's goods in commerce.

The time is ripe for the Supreme Court to update the trademark case law and bring it into harmony with the statute. The Bulova case, *Steele* v. *Bulova Watch Co.*, 344 U.S. 280; 73 S. Ct. 252 (1952) did not reach any substantive trademark question but dealt only with the matter of jurisdiction and venue. Neither

[4] The legislative history of the Lanham Act (Trademark Act of 1946) shows that the word "substantially" was deliberately intended to relax the standard of absolute exclusiveness of use required under the "ten year proviso" of the 1905 Act so as to disregard infringing uses or insignificant use by others in determining "secondary meaning".

did the Dairy Queen case, *Dairy Queen, Inc.* v. *Wood,* 369 U.S. 469; 82 S. Ct. 894 (1962) get down to the real meat of the trademark issue since it only went into the contract issue.

If the present petition for writ of certiorari is not granted, it will mean that the Commissioner of Patents will be depriving petitioner of its lawful right to oppose the application of Weather-Rite for registration of "GOODYEAR DELUXE BY WEATHER-ITE" and thus deprive the Supreme Court forever of the opportunity to pass on the correctness of the inconsistent actions of the Commissioner of Patents and the Courts of the District of Columbia Circuit with respect to the criteria for publication of a mark a second time. Upon publication a second time, an opposition can be filed by petitioner or others who may have a ground for opposition now but did not have sufficient grounds on the basis of the mark as first published and the Patent Office and the Courts can reach the merits of the question as to whether or not Weather-Rite is entitled to receive a registration which includes a mark as to which petitioner has established a "secondary meaning" as a trademark and trade name on its own behalf over the years long since 1888.

2. Consideration of Cases Involving Surname Trademark Rights Long Overdue

Several petitions for writs of certiorari have been filed in the Supreme Court in an effort to have it review and settle the case law regarding exclusive rights in surnames as trademarks. See for example *S. C. Johnson & Son, Inc.* v. *Johnson Products Co.,* cert. den. 338 U.S. 860; 70 S. Ct. 103 (1949); *S. C. Johnson & Son, Inc.* v. *Phil J. Johnson et al.,* cert den. 361 U.S.

820; 80 S. Ct. 65 (1959); and *Staley Milling Co.* v. *A. E. Staley Mfg. Co.*, cert. den. 357 U.S. 928; 78 S. Ct. 1371 (1958).

The antiquated cases of *Singer Mfg Co.* v. *June Mfg. Co.*, 163 U.S. 169; 16 S. Ct. 1002 (1896); *Howe Scale Co.* v. *Wykoff, Seamans & Benedict*, 198 U.S. 118; 25 S. Ct. 609 (1905); *Thaddeus Davids Company* v. *Davids*, 233 U.S. 461; 34 S. Ct. 648 (1914); and *L. E. Waterman Company* v. *Modern Pen Company*, 235 U.S. 88; 35 S. Ct. 91 (1914) have, most surely, been superseded by later development of the trademark law relating to exclusivity in surname trademarks, but yet are urged upon the lower Courts every time a surname case arises, since they have neither been overruled, distinguished, nor clarified by the Supreme Court.

The Patent Office itself would benefit greatly by a current review of the 1888 decision of the Supreme Court in *Goodyear's India Rubber Glove Mfg. Co.* v. *Goodyear Rubber Company, supra.* In Opposition 44,248, *The Goodyear Tire & Rubber Company* v. *Irving Raincoat Co.*,[5] the Trademark Trial and Appeal Board, on January 14, 1965, commented on the 1888 decision of the Supreme Court in this way:

> "Applicant moves for summary judgment under the provisions of Rule 56 FRCP on the ground that there is no triable issue of fact as to whether

[5] In that proceeding, registration of "GOODYEAR DELUXE BY IRCO" is being sought. The specimens corresponding to the goods named in the application were on file at the time of publication, and there was no re-examination of the application after publication, as was true in the case at bar. The specimens in that application showed on their face that the goods were imported from Japan and the lawfulness of use of the mark and the applicant's claim of ownership thereof were challenged by the Examiner and are in issue in the pending opposition.

opposer has any rights in the term 'GOODYEAR' since the Supreme Court in *Goodyear Glove Manufacturing Company* v. *Goodyear Rubber Company,* decided in 1888, held that the name 'GOODYEAR RUBBER COMPANY' or any abbreviation thereof is not capable of exclusive appropriation. A brief in opposition to the motion has been filed by opposer.[1]

* * * *

"In the absence of any evidence of privity, opposer is not estopped by the above cited decision from maintaining this proceeding; hence, the issue turns on whether the decision in question represents the law in this case.

"In this regard we are not satisfied that the showing made by applicant in support of the motion excludes any real doubt as to the existence of any genuine issue of material fact considering the substantial changes in the law and the absence of any facts of sufficient probative force to establish that the reasons upon which the Supreme Court decision was grounded more than seventy-five years ago are equally applicable today. Even

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[1] Applicant has filed a reply brief to opposer's response which opposer seeks to strike. Opposer also requests in the alternative an oral hearing on the various pending motions.

There is no provision in the rules for the filing of a response to a reply brief on a motion; and applicant's brief will not therefore be considered. See: *The Electric Storage Battery Company* v. *Mine Safety Appliances Company,* 140 USPQ 671 (TT&A Bd., 1963). Even if such a brief were to be considered, the mere fact that the designation "GOODYEAR RUBBER COMPANY" or similar appellations have been disclaimed on a number of occasions by a third party in obtaining trademark registrations before this Office under the Act of 1905 is not conclusive upon the question because whatever inferences may be drawn therefrom conflicts with such deductions as may be obtained from the fact that no disclaimer was entered by opposer in Registration No. 57,590 for "GOODYEAR" & design. See: *Paul E. Hawkinson, supra.*

In view of the foregoing, there is no occasion to consider opposer's alternative request.

assuming arguendo that the term "GOODYEAR" is not capable of exclusive appropriation, the case is still not in condition for summary judgment inasmuch as this would not dispose of the question of likelihood of confusion as between applicant's mark which includes the phrase "GOODYEAR DELUXE BY" and opposer's mark "GOODYEAR DELUXE" as applied to the specified goods. It is concluded, therefore, that the summary judgment procedure is inapplicable."

II. CONCLUSION

Admittedly, an overwhelming burden rests on petitioner to establish, on a petition for rehearing, why the Court should take the present case, having once denied certiorari. Petitioner has tried, therefore, to avoid repetition of grounds urged in the original petition and to lay emphasis on new grounds, at least some of which may appeal to the Court as being meritorious. The entire thrust of the present petition is to appeal to the sensibilities of the Court in a calm, dispassionate manner. As a consequence, petitioner hopes that the impact of this petition will be such as to convince the Court that the relatively short time which would be required to dispose of the case on its merits will induce the Court to find a few minutes on its heavy calendar to hear us out.

There is precedent for granting a petition for rehearing where the litigation to which the question pertains is concentrated in one circuit and the likelihood of a conflict arising in another circuit is remote. *Schriber-Schroth Co.* v. *Cleveland Trust Co., supra.*

There is also precedent for reviewing, in the light of changed circumstances, decisions of the Supreme Court which were rendered more than three-quarters of a century ago against a background which no longer

exists or which has so changed as to warrant a different result. *Brown* v. *Board of Education,* 347 U.S. 483, 492-3; 74 S. Ct. 686, 691 (1954) and related cases.

There is also precedent for re-examining the case law where a reasonable length of time has lapsed since the enactment of a new statute or so-called codification of the case and statutory law.[6] *Graham* v. *John Deere Co.,* 379 U.S. 956; 86 S. Ct. 684 (1966).

Where there is no precedent, the Supreme Court is in a position to set the precedent by granting certiorari and taking the case on its merits, particularly where, as here, the fact situation is simple but the underlying principles and their effect on the public are substantial. The administrative process, affecting the life of every citizen, as it does, requires application of that ultimate judicial review and scrupulous analysis which only the Supreme Court can provide.

In conclusion, petitioner prays that the present petition for rehearing be granted and that the writ of certiorari sought in the original petition and the present petition be granted.

Respectfully,

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[6] The Trademark Act of 1946 has been in force now for nearly 20 years, during which time the Supreme Court has not considered Section 2(f) of the Act in the light of the change from the "ten year proviso" of the 1905 Act or the common law cases involving exclusive right to use of a surname, a descriptive term or a geographical term as a trademark.

CERTIFICATE OF COUNSEL

I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay and is restricted to grounds specified in Rule 58 of the rules of this Court.

.....

Counsel for Petitioner.